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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,969	10/31/2005	Pierre Lebot	272252US6PCT	1729

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

NOTIFICATION DATE	DELIVERY MODE
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09/07/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/534,969

Applicant(s)

LEBOT ET AL.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 37-54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/5/2005</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Preamble-Intended Use

The preamble of claim 37 recites functional intended use limitations that are not taken in combination with the positively recited structure as follows:

- In lines 1-5 of the preamble of claim 37, it appears that the applicant does not intend to positively claim “configured to cooperate in a plate made of a brittle material of glass type to allow, in cooperation with connecting element, the plate to be mounted on a support, wherein the insert is configured to be received or formed in situ in a hole having retaining walls of curved profile and to be self-locking in the hole, the hole being made in one face of the plate”. For purposes of examination the examiner has considered the claims without combination. “(T)he recitation of a new intended use for an old product does not make a claim to that old product patentable”, In re Schreiber, 44 USPQ2d1429 (Fed. Cir. 1997). Accordingly, the prior art meets the applicant’s claimed intended use merely by being capable of such intended usage regardless of whether or not such capability is expressly disclosed (i.e., wherein capability is inherent to the disclosed structure). If the applicant wishes to positively recite the above intended use phraseology then the limitation “configured to” (lines 1 and 3 of claim 1) should be replaced with positive terminology. Otherwise, it is well established that patentability of a device is based on the structural recitations thereof and not how such structure is intended to be used. The claims are drawn solely to “An insert” and it is that “insert” structure for which patentability is to be determined.

Claim Objections

Claims 38-40 and 45-54 are objected to because of the following informalities:

- Claims 38-40 and 45-54 refer to the intended use phraseology noted in the "Preamble-Intended Use" section above in a positive manner. All such references to a mere intended use must be functional in nature (i.e., "operable to", "shaped for", "configured for", etc.) in the interest of claim clarity. Note that positive reference to an intended use limitation renders the claims unclear as to what is being positively claimed and what is mere intended use.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with errors. Take for instance the following examples:

- In line 2 of claim 37 and elsewhere throughout the claims, the phrase "glass-type" renders the claims indefinite because the addition of the word "type" to an otherwise

definite expression extends the scope of the expression so as to render it indefinite. It is unclear what the word “type” is intended to convey. For purposes of rejection under the prior art the examiner takes the term to mean any material that shares some glass property with glass (i.e., transparency, refraction, etc.)

- It is unclear what the term “obtained” (line 5 of claim 37) is meant to convey. Is the insert supposed to be the removable component? Is the insert supposed to be taken from a portion of the removable component? Is the insert transported by a removable component?
- The term “the inside” (line 2 of claim 38) lacks proper antecedent basis in such a way that it is unclear what element is being referred to. Is it the inside of the hole, the inside of side wall, the inside of the plate, etc.?
- It is unclear what the limitation “based on” (line 1 of claim 41) is meant to convey. Is the insert a cup-shaped element? Does not insert have a base placed on a cup-shaped element? Is the insert merely similar to a cup-shaped element?
- The term “the cup” (line 2 of claim 41) lacks proper antecedent basis.
- The term “its sidewalls” (line 3 of claim 41) is unclear since the term lacks proper antecedent basis and further since the pronoun “its” is ambiguous.
- The term “the glass plate” (last line of claim 43) lacks proper antecedent basis. Does the term mean to further limit the previously recited glass type plate to actually be made of glass? Does the term mean to set forth an element separate from the previously set forth glass type plate?

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- It is unclear if the term “A plate” (line 1 of claim 47) is meant to set forth a plate separate from the plate previously set forth in claim 37 or meant to refer to the claim 37 plate.
- Claim 47 positively recites a plate that is merely intended to be used with an insert. However, claim 47 depends from claim 37 which recites an insert that is merely intended to be used with a plate. Accordingly it is unclear what, if any, elements are meant to be positively claimed in claim 47.
- The past-tense term “has” (line 1 of claim 49) renders the claim unclear with regard to the current claimed state. Does the term mean to say that each insert is received in the final product invention or rather merely describe previous location of parts prior to assembly?
- The term “the glass” (line 1 of claim 50) lacks proper antecedent basis such that it is unclear whether the term is intended to further limit the previously set forth glass type panel to be actually made of glass, or set forth an additional separate element, or refer to the glass type panel without further limiting it to actually be made of glass.
- Claim 54 positively recites a process for making a plate that is merely intended to be used with an insert. However, claim 54 depends from claim 37 which recites an insert that is merely intended to be used with a plate. Accordingly it is unclear what, if any, elements are meant to be positively claimed in claim 54.

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner’s best understanding of the

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claim scope. The applicant is strongly urged to amend the entirety of the claims (not only the examples listed above) to conform to current U.S. practice.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37-40, 47-49 and 51-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer (U.S. Patent 5,106,250).

Claim 37. Fischer discloses (figs. 1a-7) an insert (7) made of a deformable (deformation described in col.3, ll.10-60) material. The specific method of forming is not germane to the issue of patentability of the device itself. See MPEP § 2113. It is well established by case law that it is the patentability of the product that is to be determined even though such claims are limited and defined by process steps. See *In re Thorpe et al*, 227 USPQ 964 (CAFC 1985). Therefore, the limitation “obtained from at least one removable component” has been given only limited patentable weight. Furthermore the prior art is fully capable of functioning as follows:

- The prior art insert is **configured to cooperate** (but not necessarily cooperating) in a plate made of a brittle material of glass type, to allow, in cooperation with a connecting element, the plate to be mounted on a support (since the prior art insert is configured to have long narrow dimensions capable of such function).

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- The prior art insert is **configured to be received or formed** (but not necessarily received or formed) in situ in a hole having retaining walls of curved profile and to be self-locking in the hole, the hole being made in one face of the plate (since the prior art insert is configured to have long narrow dimensions capable of such function).

Claim 38. Fischer discloses the insert as claimed in claim 37, wherein the insert is **configured to be received or formed** (but not necessarily received or formed) in situ in a hole bounded by a side wall of concave profile, the concavity being turned toward the inside (since the prior art insert is configured to have long narrow dimensions capable of such function).

Claim 39. Fischer discloses the insert as claimed in claim 37, wherein the insert is **configured to be received or formed** (but not necessarily received or formed) in situ in a hole that is a blind hole or a through-hole (since the prior art insert is configured to have long narrow dimensions capable of such function).

Claim 40. Fischer discloses the insert as claimed in claim 37, wherein the insert is **configured to be received or formed** (but not necessarily received or formed) in situ in a hole that has a circular or oblong cross section (since the prior art insert is configured to have long narrow dimensions capable of such function).

Claim 47. Fischer discloses a plate (1), made of a brittle material of the glass type (i.e., in that it is refractory as indicated by its cross hatching, see 35 USC 112 2nd rejection above), including on at least one of its surfaces a hole (4).

- The prior art hole is configured to receive at least one insert as defined in claim 37 (in that it has a cavity fully capable of such function).

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Claim 48. Fischer discloses the plate as claimed in claim 47, equipped with at least one insert (7).

Claim 49. Fischer discloses the glass type plate as claimed in claim 48, wherein each insert has received a connecting element (9).

- The prior art connecting element is configured to cooperate with a support (in that it has threads that are fully capable of such function).

Claim 51. Fischer discloses a mounted assembly (assembly of figs. 1a-7) or assembly to be mounted, comprising at least one plate as defined in claim 47.

Claim 52. Fischer discloses the assembly as claimed in claim 51, including a wall cladding element (27), an interior furnishing, a partition, or a piece of furniture.

Claim 53. Fischer discloses a heating element comprising a plate as defined in claim 47.

- The prior art plate is configured to be provided with at least one of conducting elements (such as metal element 27 which is inherently a conductor of electricity and heat), screen-printed elements, and with current leads.

Claim 37 and 41-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Studer (U.S. Patent 6,146,383).

Claim 37. Studer discloses (figs. 5 and 10) an insert (10) made of a deformable material (metal as denoted by cross-hatching). The specific method of forming is not germane to the issue of patentability of the device itself. See MPEP § 2113. It is well established by case law that it is the patentability of the product that is to be determined even though such claims are limited and defined by process steps. See *In re Thorpe et al*, 227 USPQ 964 (CAFC 1985).

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Therefore, the limitation "obtained from at least one removable component" has been given only limited patentable weight. Furthermore the prior art is fully capable of functioning as follows:

- The prior art insert is **configured to cooperate** (but not necessarily cooperating) in a plate made of a brittle material of glass type, to allow, in cooperation with a connecting element, the plate to be mounted on a support (since the prior art insert is configured to have long narrow dimensions capable of such function).
- The prior art insert is **configured to be received or formed** (but not necessarily received or formed) in situ in a hole having retaining walls of curved profile and to be self-locking in the hole, the hole being made in one face of the plate (since the prior art insert is configured to have long narrow dimensions capable of such function).

Claim 41. Studer discloses the insert as claimed in claim 37, based on a cup-shaped element (10 is cup-shaped in as much as applicant's element 8 is), the cup having radial slots (12) made in its side wall, thus forming petals (petals between 12),

- The prior art element is configured to be introduced into a corresponding hole in a plate (in that it is configured with an outer dimension that is fully capable of such function).
- The prior art petals are configured to bend elastically or plastically inward to allow the element to be fitted into a corresponding hole in a plate (in that they are configured to be flexible and thus fully capable of such function).
- The prior art internal surface of the sidewall of the cup-shaped element is configured to cooperate with the element for connecting a glass plate to a support (in that it is configured with an outer dimension fully capable of such function).

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Claim 42. Studer discloses the insert as claimed in claim 41, wherein the cup-shaped element is of circular shape (in horizontal cross-section).

Claim 43. Studer discloses the insert as claimed in claim 41, wherein the cup-shaped element includes three to five slots (12).

Claim 44. Studer discloses the insert as claimed in claim 39, wherein the element has a curved bottom or a curved pierced bottom (bottom of 10).

Claim 45. Studer discloses the insert as claimed in claim 37, wherein:

- The prior art insert is fully capable of performing the intended use of being for cooperation with a connecting element.
- The prior art insert is configured for self-locking within a hole (in that the insert is configured with an outer dimension fully capable of such function).

Claim 46. Studer discloses the insert as claimed in claim 37, wherein:

- The prior art insert sidewall is fully capable of performing the intended use of being for insertion into a hole with a wetting agent for improving surface appearance interposed at an interface there between.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 50 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (U.S. Patent 5,106,250).

Claim 50. Fischer discloses the plate as claimed in claim 47, but does not expressly state that the panel is toughened, tempered, annealed, or mechanically reinforced glass. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Furthermore, the applicant has failed to demonstrate criticality by any showing of unexpected result derived from a non-toughened, non-tempered, non-annealed, or non mechanically reinforced materials over a toughened, tempered, annealed or reinforced glass. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a toughened, tempered, annealed or mechanically reinforced glass for the Fischer panel since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

Claim 54. Fischer discloses a plate (1) made of a brittle material of the glass type that has a hole (4) at a place of fastening points each hole having a shape and an insert of complementary shape being placed in the hole. Fischer does not expressly state what process was used to make the plate itself. The examiner takes official notice that it is extremely well known in the art to

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take a non-heat treated plate, machine a hole therein, and then carry out a heat treatment on the plate, for the purpose of increasing the strength of the plate. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to make the Fischer plate by a process including the steps of machining a hole in a non-heat treated plate and then heat treating the plate for the purpose of increasing the strength of the plate.

- The prior art plate is configured to be mounted on a support to constitute a mounted assembly.
- The prior art hole shape is fully capable of performing the intended use of being for to allow an insert as defined in claim 37 to be introduced and retained.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Referring to inserts:

Kimberlin U.S. Patent 3,310,993.

Markey U.S. Patent 3,476,010


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

August 30, 2007



Victor L. MacArthur
Patent Examiner
Art Unit 3679